

U.S. Serial No.: 10/717,632

Docket No. SAIC0055-C-CIP2

REMARKS

Claims 1-8 and 40-46 are pending in the current application. Claims 1, 42 and 43 have been amended. Claim 47 has been cancelled. The claims have been addressed as follows in the non-final Office Action: claims 1-6, 8, 40-42 and 47 are rejected under 35 USC 103(a) as being unpatentable over Bermbach in view of Adams et al. and Geus; and claim 7 is similarly rejected over Bermbach in view of Adams et al. and Geus and further in view of Kubierschky; claims 43-46 are similarly rejected as being unpatentable over Bermbach in view of Adams et al. and Geus and further in view of Johnston.

The undersigned requests reconsideration of the rejections from the non-final Office Action in view of the amendments to claim 1 and the remarks below.

Rejection of Claims 1-6, 8, 40-42 and 47 under 35 USC 103(a) in View of Bermbach, Adams et al. and Geus

The undersigned incorporates herein the arguments from the previous responses filed May 30, 2006 and August 2, 2006. Additionally, the undersigned has amended claim 1 in order to more particularly point out the difference between the claimed invention and the disclosure of Bermbach, Adams and Geus. Claim 1 currently reads as follows:

1. (Currently Amended) A target object inspection system comprising:
 - a first detector for detecting radiation from a radiation source;
 - a second detector for detecting radiation from the target object;
 - a mobile platform including the first detector, the second detector and the radiation source; and
 - a boom connected to the radiation source at a first end of the boom and the mobile platform at a second end of the boom, wherein the first end of the boom is deployed so as to effect passage of the target object between the radiation source and the first and second detectors, and further wherein the mobile platform and the target object pass alongside one another during inspection;

the mobile platform being capable of inspecting a target object either when the mobile platform is stationary or when the mobile platform is moving.

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The undersigned summarizes below each of the teachings of the various references cited.

In Bernbach, the target actually moves into a stationary platform during inspection as shown below in FIG 1 of Bernbach and thus does pass alongside the target object during inspection. Bernbach does not teach or suggest a second detector for detecting radiation from the target object. And, the stationary inspection platform in Bernbach is not capable of moving during inspection.

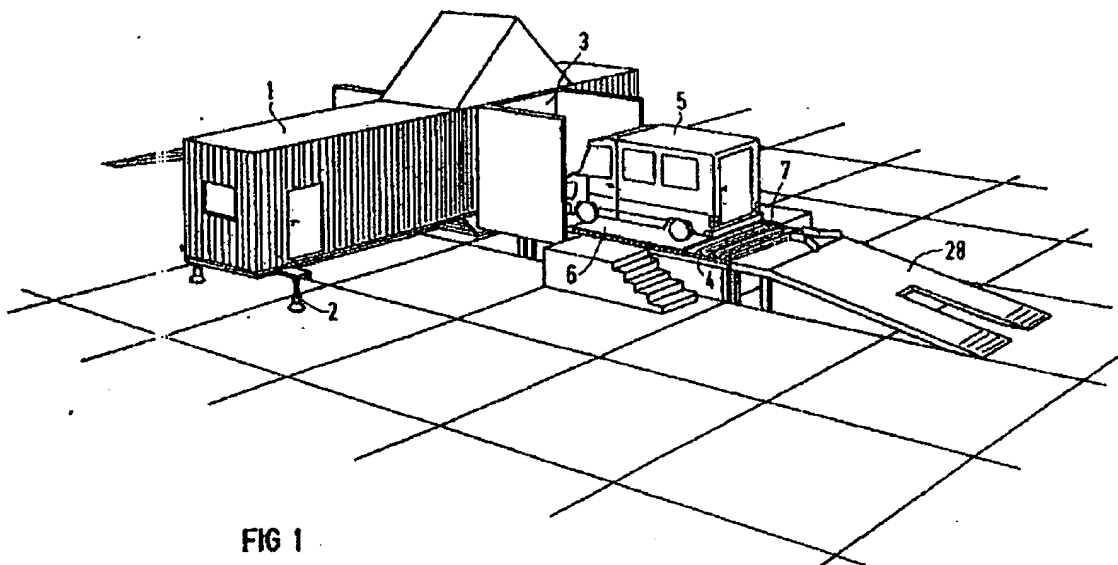


FIG 1

Adams was cited for teaching the use of a second detector for detecting radiation from the target object. Importantly, Adams clearly teaches away from the system described in Bernbach and in the claims. The system described in Adams requires that the radiation source and detectors be on the same side of the target object during inspection, i.e., the target object does not pass between the radiation source and either of the first or second detectors. Accordingly, even if it is permissible that this particular teaching of Adams, i.e., use of passive detection, is available to support the Office's statement that passive detection is well known, it is not permissible to use

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other teachings of Adams in combination with Bermbach to support a *prima facie* case of obviousness. It is improper to combine references where the references teach away from their combination. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); MPEP § 2145.

In paragraphs [0003] and [0004] under the heading BACKGROUND OF THE INVENTION, Adams unequivocally states the current or known technology (as compared to that described by Adams): “requires that inspected objects or people either be moved through an inspection system (e.g., Bermbach) or interposed between a proximal examining component and a distal examining component, one including a source and the other including a detector (e.g., Current Application).” And that the system of Adams does not impose the requirements or constraints of these known systems. As such, the Office still has not provided a reference that teaches or suggests the limitations wherein the mobile platform is capable of both moving or remaining stationary during inspection of the target object and wherein the mobile platform and the target object pass alongside one another during inspection.

Finally, Geus was cited by the Office as evidence for the Office’s statement that inspection systems which pass alongside a target object are “well known in the art” and that “absent some degree of criticality” this limitation is “a matter of routine design choice within the skill of a person of ordinary skill in the art depending on the needs of the application.” With all due respect, the subject matter recited in the current application and claims, as well as the cited art, is not the type of technology which lends itself to “routine design choices.” Further, the Office has provided no statute, regulation, case law or even an MPEP cite which supports the acceptability of this rationale. Since this reasoning is not provided for by statute or rule, the undersigned can only surmise that such a rationale is found in the case law. Per MPEP § 2144, the undersigned wishes to remind the Office that legal precedent can provide the rationale supporting obviousness only if the facts in the case are sufficiently similar to those in the application.¹ Accordingly, in order to establish a *prima facie* case of obviousness using this

¹ The examiner must apply the law consistently to each application after considering all the relevant facts. If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by

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rationale, the Office must first identify the legal precedent, i.e., case law, and next identify how the facts of the case are sufficiently similar to those in the current application. Further, the undersigned submits that the language requiring that the target object and the mobile platform pass alongside one another during inspection is indeed critical to the invention – the invention does not work any other way. As such, the “design choice” rationale is not sufficient to support a *prima facie* case of obviousness.

The undersigned submits that the combination of Bermbach, Adams and Geus fails to teach each of the limitations of the claims and even assuming, *arguendo*, that the limitations are taught by the references individually, there is no motivation to combine the teachings. Adams teaches away from the claimed combination and the undersigned submits that the “design choice” motivation to combine Geus with Bermbach was either insufficient as presented or is hereby rebutted since the particular limitation is critical. The undersigned respectfully submits that claims 1-6, 8, 40-42 are allowable over the cited art.

In addition to the reasons set forth above, the undersigned submits that the Office has failed to establish a *prima facie* case of obviousness for claim 42. The Office does not provide a reference teaching the claimed modes, but merely states that they are “well known in the art” and “would have been obvious design choice.” Again, no authority is given for this reasoning.

Referring to MPEP 2144.03:

B. If Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line Of Reasoning Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). In certain older cases, official notice has been taken of a fact that is asserted to be “common knowledge” without specific reliance on documentary evidence where the fact noticed was readily verifiable, such as when other references of record supported the noticed fact, or where there was nothing

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the court. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

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of record to contradict it. See *In re Soli*, 317 F.2d 941, 945-46, 137 USPQ 797, 800 (CCPA 1963) (accepting the examiner's assertion that the use of "a control is standard procedure throughout the entire field of bacteriology" because it was readily verifiable and disclosed in references of record not cited by the Office); *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943) (accepting the examiner's finding that a brief heating at a higher temperature was the equivalent of a longer heating at a lower temperature where there was nothing in the record to indicate the contrary and where the applicant never demanded that the examiner produce evidence to support his statement). If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

The Office has clearly failed to provide the required evidence or sound technical reasoning to support the rejection of claim 42. Further, as discussed above, the undersigned suspects the "design choice" rationale is based on some case law, but there is a process for applying such rationale, i.e., a showing of similar facts, etc. and that has not been done in the case. Accordingly, even if a teaching for the limitation of claim 42 had been provided, there is no motivation to combine with the references cited.

Rejection of Claim 7 under 35 USC 103(a) in View of Bermbach, Adams et al., Geus and Kubierschky

For the reasons stated above with respect to independent claim 1, the undersigned submits that dependent claim 7 is also allowable.

Rejection of Claims 43-46 under 35 USC 103(a) in View of Bermbach, Adams et al., Geus and Johnston

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For the reasons stated above with respect to independent claim 1, the undersigned submits that dependent claims 43-46 are also allowable. Additionally, claim 43 has been amended to include a processor that utilizes velocity and detector data to image the target object.

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CONCLUSION

The undersigned submits that claims 1-8 and 40-46 are allowable over the cited art for the reasons set forth herein and awaits a notice of allowance to this effect. Should the Office have additional questions which would facilitate efficient prosecution of this application, please do not hesitate to contact undersigned at the number provided below.

Respectfully submitted,

Date: October 4, 2006

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